

REMARKS / ARGUMENTS

By this Amendment, Applicants respond to the Office Action dated January 4, 2005 ("the Office Action"), in which claims 91-123 and 125-137 were rejected. With this Amendment, Applicants have canceled claims 102, 116-117, 123-126 and 138-139, without prejudice, and have amended claims 91, 103, 113-114, 119-122, 127, and 131. Accordingly, claims 91-101, 103-115, 118-122, and 127-137 are now pending.

Rejection of Claims under 35 U.S.C. §§ 102(e)

In the Office Action, the Examiner rejected all of the pending claims under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 5,638,443 A to Stefik et al. ("Stefik").

Although Applicants respectfully disagree with basis for this rejection, in order to expedite prosecution of this application Applicants have amended independent claims 91, 121, and 127 and respectfully submit that the amended claims are even more clearly allowable over Stefik. In particular, Applicants respectfully submit that Stefik does not teach or suggest the separate transmission of protected information and the rules or controls that govern the protected information, as recited in amended claims 91, 121, and 127. Instead, Stefik emphasizes that "a key feature of the present invention is that usage rights are permanently 'attached' to the digital work," Stefik at col. 5, lines 62-63, and that "the present invention never separates the fee descriptions from the work," Stefik at col. 6, lines 11-12. For at least this reason, Applicants respectfully submit that claims 91, 121, and 127 are allowable over Stefik.

Claims 92-101, 103-115, 118-120, 122, and 128-137 are dependent on claims 91, 121, or 127, and are thus allowable for at least the reasons set forth above in connection with claims 91, 121, and 127.

Rejection of Claims 114 under 35 U.S.C. § 103(a)

The Examiner rejected claim 114 under 35 U.S.C. 103(a) as being unpatentable over Stefik, as applied to claim 113, and further in view of PCT Published Appln. No. WO 93/01550A1 to Infologic Software, Inc. ("Griswold").

As stated above, claim 114 is ultimately dependent on claim 91, and is thus allowable for at least the reasons set for above in connection with claim 91. Moreover, without acquiescing to the correctness of the instant combination of references, Applicants also respectfully submit that Griswold fails to disclose or suggest the same teachings noted above and in Applicants' September 22, 2004 Response as being absent from Stefik. Therefore, Applicants respectfully submit that claim 114 is patentable over Stefik and Griswold, alone or in combination.

Claim Amendments

In addition to the amendments described above, claims 91, 103, 113-114, 119-122, 127, and 131 have been amended to remove certain limitations, to improve readability, and to conform with amendments made to the other claims. It will be appreciated that these amendments have not been made for purposes of patentability.

Appln. No. 09/764,370
Amdt /Response to Office Action filed w/ RCE
replying to Office Action of 1/4/05

PATENT
Customer No. 22,852
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CONCLUSION

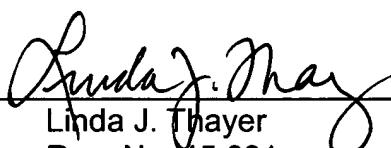
In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in allowable form, and respectfully request reconsideration of the rejections and the timely allowance of the claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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